

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mostafazadeh, et al.

Application No.: 09/399,585

Filed: September 20, 1999

For: LEAD FRAME CHIP SCALE  
PACKAGE

) Attorney Docket: NSC1P217D1

) Group Art Unit: 2813

) Examiner: N. Berezny

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail to: Commissioner for Patents, Washington, DC 20231 on November 14, 2002.

Signed

*Lara M. Nelson*

Lara M. Nelson

PETITION REQUESTING REVERSAL OF EXAMINER'S REFUSAL TO ENTER  
AMENDMENTS TO THE SPECIFICATION  
PURSUANT TO 37 CFR 1.181

Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

A final rejection was entered in the above referenced application on May 15<sup>th</sup>, 2002. The final rejection originally (1) refused entry of drawing corrections proposed on January 24, 2002; (2) refused entry of amendments to the specification filed March 6, 2002; and (3) rejected all of the pending claims based on certain prior art. The rejection of the claims was subsequently withdrawn in an Advisory Action dated June 18<sup>th</sup>, 2002. Thus, the Examiner has indicated that all of the pending claims (i.e., claims 1-4 and 11-29) are allowable. **Accordingly, the only outstanding issues in this application are the refusal to enter certain amendments and proposed drawing corrections.** Therefore, it is believed that a petition to the Commissioner as

opposed to an appeal to the Board is appropriate to seek review of the outstanding issues.

### ISSUES TO BE REVIEWED

The primary issues that are the subject of this petition are:

- 1) Whether amendments to the specification that merely move subject matter from one section of an application (the background) to a second section of an application (the detailed description of the invention) constitutes “new matter”, thus supporting the Examiner’s objections to the specification under 35 USC 132;
- 2) Whether the removal of an improper label on a drawing that identifies the drawing as “prior art” constitutes “new matter”, thus supporting the Examiner’s refusal to enter certain amendments to the drawings; and
- 3) Whether the discussion of part of an invention in the background section of an application constitutes an uncorrectable admission of prior art that cannot be corrected or rescinded.

### OVERVIEW OF THE FACTS BEHIND THE ISSUES PRESENTED

Figures 1(a) and 1(b) of the present application illustrate a section of a lead frame panel that the Applicants believe is part of their invention. Figure 1(c) illustrates a single package (out of many) that is made from the lead frame panel illustrated in Fig. 1(a). Applicants believe that this resulting package is also their invention. Unfortunately, Figures 1(a)-1(c) were described in the background section of the application. Therefore, the Examiner has effectively treated the subject matter of Figures 1(a)-1(c) as Applicant’s admitted prior art (AAPA). The inventors unequivocally believe that they are the inventors of the subject matter illustrated in Figures 1(a)-1(c) and they are not aware of any disclosures or uses that could constitute prior art under the patent laws. Therefore, they have sought to rescind any implied or express admission that Figures 1(a)-1(c) constitute prior art.

The amendment to the specification set forth in the amendment filed March 6<sup>th</sup>, 2002 sought to move the description of Figures 1(a) –1(c) from the background section of the application to the detailed description section of the application. These amendments were objected to under the premise that they constitute new matter. It is believed that the Examiner and the Applicant agree that the proposed amendments to

the specification do not include any changes in the technical description that constitute new matter. Rather, it is simply that the proposed amendments are designed to eliminate any implication that the subject matter shown in Figure 1(a) – 1(c) constitutes prior art to the present application. It is the undersigned's understanding that the Examiner's position is effectively that the description of the subject matter of Figures 1(a)-1(c) in the Background section of the application is an admission of prior art and that any attempt to withdraw such an admission would constitute new matter and is therefore not permitted. Thus, the primary issues presented relate to whether the description in the background constitutes an admission of prior art, and if so, whether it is possible to rescind such an admission if it is discovered that such an admission was inadvertent or in error.

For the reasons set forth below, it is respectfully submitted that amendments to the specification that only move the location of an explanation and do not in any way alter the scope or nature of the technical disclosure cannot as a matter of law constitute **new matter** even if they effectively remove an improper, implied or express admission of prior art. It is also respectfully submitted that as a matter of law, **during prosecution**, an applicant should be and is entitled to rescind an express or implied admission that their own prior work somehow constitutes prior art when it is clear that such an admission was improper.

**A DISCUSSION OF APPLICANT'S OWN PRIOR WORK CAN NOT BE TREATED AS PRIOR ART IN THE ABSENCE OF A STATUTORY BAR**

Section 2129 of the MPEP correctly points out (citing *In re Nomiya*, 184 USPQ 607,610 (CCPA 1975)) that admissions by applicant may generally be treated as prior art. However, the undersigned is not aware of anything in the MPEP or in the case law that suggests that an Applicant cannot correct an improper characterization of the Applicant's own earlier work as "prior art." Rather as pointed out further on in MPEP section 2129 (citing *Reading & Bates*):<sup>1</sup> **"[a]n applicant's own foundational work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted."**<sup>2</sup> Like in *Reading & Bates*, "*Nomiya* is distinguishable from the case at hand, on the same basis *Fout* was distinguished

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<sup>1</sup> *Reading & Bates Construction Co. v. Baker Energy*, 223 USPQ 1168 (Fed. Cir. 1168).

<sup>2</sup> See MPEP section 2129.

from *Ehrreich* – the existence of a common inventive entity as both the applicant for patent and the inventor of the alleged ‘prior art’.”<sup>3</sup>

*In re Nomiya* and many other cases have dealt with situations where an inventor described certain activities *of others* that were known to the inventors before their own invention of the subject matter of the applicant as prior art. Under the law at the time, it was clear that such prior knowledge should be treated as prior art and the applicants never argued that they had not received the information from others prior to their own invention. (For example, it is believed that the art at issue in *Nomiya* would have been prior art under the principle that is 35 USC 102(f) today). This is a very different scenario than the present case. Specifically, in the present case, the background section of the originally filed application described a lead frame and package design (illustrated in Figs. 1(a)-1(c)) **that was the inventors’ own work**. In situations where a discussion in the background describes the applicant’s own work that is not the subject of any known statutory bar, such a discussion **should not** be treated as an irrevocable admission of prior art.

It is noteworthy that the relevant drawings (Figs. 1(a)-1(c)) as originally filed WERE NOT labeled as prior art. During prosecution, Applicant’s previous counsel made an amendment to the drawings labeling Figs. 1(a)-1(c) as prior art without first checking with the inventors. The inventors have unequivocally stated that the subject matter of Figs 1(a)-1(c) (which is the subject matter that the amendments sought to move from the background to the detailed description portion of the application) is their own work and not, to the best of their knowledge, subject to any statutory bars. Therefore, it is respectfully submitted that any presumption that the subject matter of Figs. 1(a)-1(c) is prior art that may have been implied by discussing this work in the background section of the application has been successfully rebutted by the inventors statements that those figures illustrate their own earlier work and that they are unaware of any events that would cause that work to constitute a statutory bar. By way of example, the remarks section of the amendment fax filed on March 6, 2002 included an express statement to that effect. See, e.g., page 10, lines 12-14 of the

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<sup>3</sup> *Reading & Bates Construction Co. v. Baker Energy*, 223 USPQ 1168, 1172 (Fed. Cir. 1168). The cites for the referenced Fout and Ehrreich cases are: *In re Ehrreich*, 200 USPQ 504 (CCPA 1979) and *In re Fouts*, 213 USPQ 532 (CCPA 1982).

amendment fax filed March 6, 2002. Additionally, so that the record is clear, a declaration of the inventors confirming that Figs. 1(a) – 1(c) illustrate their own work accompanies this petition.

Since the subject matter of Figs. 1(a)-1(c) illustrate the inventors' own work, it is respectfully submitted that they may, as a matter of right, eliminate any inference in the application that such work is somehow prior art to them and that the elimination of such an inference does not in any way constitute new matter as asserted by the Examiner.

As indicated above, the amendments to the specification that have been objected to by the Examiner merely move the description of Figs. 1(a) – 1(c) from the background section to the detailed description section of the application. The Examiner has not asserted that they change the technical description of the illustrated subject matter (and the undersigned believes that they do not in any way change the technical description). It is believed that this is in direct conflict with PTO policy. Specifically, Section 2163.06 of the MPEP states (first paragraph, third sentences) **“information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”** Accordingly, it is respectfully submitted that the outstanding objections to the specification and the refusal to enter the proposed substitute sheets of drawings should be withdrawn. More specifically, it is respectfully submitted that moving the description of Figs. 1(a)-1(c) from the background section of the application to the detailed description should not be treated as new matter, in line with the practice set out in the MPEP as quoted above, and that the Examiner's pending objection to the specification should be withdrawn. Additionally, it is respectfully submitted that the proposed amendments to the drawings that merely remove the **improper** labeling of Figs. 1(a)-1(c) as “prior art” should be withdrawn. Figs. 1(a)-1(c) as filed did not bear the “prior art” labeling and so removal of that labeling does not add new matter to the application as filed. Rather, the proposed amendments to the drawings merely correct an inaccurate labeling made during prosecution and as such adds no new matter.

NOTIFICATION THAT A REISSUE APPLICATION HAS BEEN FILED

It is noted that in the Final Rejection dated May 15, 2002, the Examiner suggested that the Applicants filed a reissue application making similar changes in the issued parent application. Such a reissue application has been filed on September 27, 2002 and bears the application No. 10/260,044.

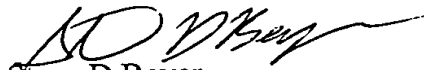
CONCLUSION

For the reasons set forth above, the Applicants respectfully request that the Examiner's outstanding objection to the specification and refusal to approve the proposed drawing corrections be withdrawn.

Should it be determined that a telephone interview would expedite the review of this petition, the office is encouraged to contact the undersigned may at (650) 961-8300. If any additional fees are due in connection with the filing of this petition, the Commissioner is hereby authorized to charge such fees to our Deposit Account No. 50-0388 (Order No. NSC1P217D1).

Respectfully submitted,

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11-14-02 has been entered.

### *Petition*

A Petition Requesting Reversal of Examiner's Refusal to Enter Amendments to the Specification pursuant to 37 CFR 1.181 was filed Nov. 14, 2002 by Applicant, wherein Examiner had objected to amendments made by Applicant to remove the "Prior Art" label from three figures and to move the description of said figures from the Related Art section to the Detailed Description section. The Petition and a declaration of inventors Mostafazadeh and Smith which declares that said figures and text were in fact part of the instant invention and should not have been labeled as Prior Art has been reviewed by a Petitions Examiner. Based upon the declaration of the inventors, the decision of USPTO is to accept the sworn statement of the inventors and allow entry of the amended figures and text in question.

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As part of said decision and upon filing of an RCE on 11-14-02, Amendments H, I, and J, filed on 5-31-02, 6-13-02, and 7-29-02, respectively have been entered.

***Allowable Subject Matter***

Pending claims 1-4 and 11-29 were previously allowed per Advisory Action no.26, mailed 6-18-02. Said claims 1-4 and 11-29 are still in condition for allowance.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6,229,200.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nema O Berezny whose telephone number is (703) 305-3445. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on (703) 308-4940. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956:

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March 4, 2003